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09/482,773	01/13/2000	John D. Dreher	2870/220	7449

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/482,773
Filing Date: January 13, 2000
Appellant(s): DREHER, JOHN D.

CYNTHIA R. MILLER
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 26, 2004.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,207,174 B1	HINENO ET AL.	03-2001
5,690,916	KIMURA ET AL.	11-1997

Hurst, S. "Face Powders" Poucher's Perfumes, Cosmetics and Soaps, vol. 3 (1993, 9th ed. Hilda Butler), Chapman & Hall, pp. 116-121.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Hineno et al. (US 6207174 B1) ("Hineno").

Kimura discloses a foundation comprising 9.0 % by weight of blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments which examiner views are used to match skin tone and thus meet the "skin color" limitation. See Example 13. While the claimed composition is disclosed in the prior art, the reference fails to explicitly teach using the composition to visibly reduce wrinkle or lines of the skin. Examiner views that wrinkle caused by chronic aging is a natural phenomena that obviously occurs in mature users' skin. Thus, examiner takes the position that the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim.

Hineno teaches using a composite powder comprising interference or reflective pigments useful in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and the 9.32 % by weight of composite powder.

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Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and the 9.32 % by weight of composite powder.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the Kimura composition as motivated by Hineno because of the expectation of successfully enhancing wrinkle-coverage effect and improving skin color tone.

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kimura and Hineno as applied to claims 1-7 and 9-11 above, and further in view of Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993).

Kimura and Hineno, discussed above, fail to teach bismuth oxychloride.

Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2nd full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide "translucent luster, or frosted effect, to enhance the wearer's natural complexion". See p. 117, 5th full par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding bismuth oxychloride as motivated by Hurst because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

(11) Response to Argument

Examiner asserts that the Office has made a prima facie obviousness case in rejecting claims 1-7 and 9-11 in view of Kimura ('916) and Hineno ('174) as above, and that applicants' arguments are not persuasive to overcome the rejection.

Applicants assert, "the examiner has merely relied on personal opinion and has provided no extrinsic evidence as proof that one skilled in the art would expect that applying the '916 reference (Kimura) composition to discolored skin would necessarily result in its application to age-wrinkled skin".

Firstly, examiner specifically relied on the objective teaching of the Hineno ('174) reference to show that it is well known in cosmetic art that interference pigments have wrinkle covering effects when applied to skin. Thus applicants' assertion that no extrinsic evidence was used to make the rejection is erroneous.

Examiner also maintains the position that the population overlap between the users of the Kimura and applicants' inventions is obvious because the prior art is a cosmetic composition of which the primary purpose is to hide imperfections of the skin. It would be reasonable to conclude that the users of the Kimura ('916) invention is used by people with aged skin which is a natural phenomena that occurs in all populations.

Applicants also assert that the Hineno ('174) reference does not cure the deficiency of the '916 reference allegedly because it leads the skilled person to select red interference pigment for use in a composition suitable for reducing the appearance of wrinkles on the skin. Applicants' rational for this argument is that the only exemplified cosmetic formulations that are disclosed in the reference uses red, and not blue pigments.

It is well settled in patent law that “the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” See MPEP § 2123, quoting In re Heck, 699 F. 2d 1331, 216 U.S.P.Q. 1038 (Fed. Cir. 1983). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 U.S.P.Q. 2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). It is also held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. The court in In re Susi also held that “a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” See 440 F.2d 442, 169 U.S.P.Q. 423 (C.C.P.A. 1971).

In this case, the reference teaches in col. 7, lines 35 – 41, “the content of the composite powder in the external composition of the present invention can be selected, as required, depending on the form or the type of the composition, the purpose of incorporating the composite powder of the present invention and the like, and it shall not particularly be limited.” No where in the reference provides teaching or suggestion, either expressively or implicitly, that only red interference pigments should be used in cosmetics for wrinkle covering effects. See col. 6, line 52 – col. 8, line 12. The use of blue interference pigments in cosmetic formulation is taught in the Kimura ('916) reference. Thus, in view of the teachings by Hineno ('714), the skilled artisan would have reasonably concluded that the Kimura method of topically applying a composition


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comprising blue interference pigments would produce wrinkle covering effects, which is claimed by applicants in this case.

Applicants' only argument against the rejection of claim 8 made in view of Kimura ('916), Hineno ('714), and Hurst is that the rejection of claims 1-7 and 9-11 is not adequate. Examiner asserts that applicants' argument is moot because claims 1-7 and 9-11 have been properly rejected in view of the Kimura and Hineno references as discussed above..


For the above reasons, it is believed that the rejections should be sustained.

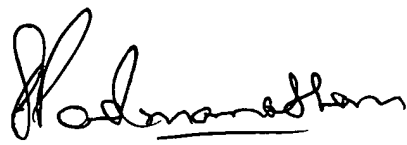
Respectfully submitted,


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May 27, 2005

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